

Serial No. 10/796,681  
Art Unit: 1713

Remarks

Restriction

Claims 1-30 are pending in the application.

Group I. Claims 1-7 and 28, drawn to a coating composition, classified in class 524, subclass, 558.

Group II. Claims 8-22 and 29 drawn to a method of making a coated metal, classified in class 427, subclass 487+.

Group III. Claims 23-27 and 30, drawn to a coated metal, classified in class 428, subclass 457+.

Applicants acknowledge the Examiner's indication that Groups II and III will be joined with Group I, if Group I is found allowable.

Priority

A certified copy of the required priority document is being mailed herewith.

Rejections

The claims of Group 1, claims 1-7 and 28, have been examined and stand rejected. Claim 1 has been amended hereby. Arguments made in this rejection are with reference to the claims as amended.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shustack et al. (US 5,128,391). Applicants respectfully traverse the rejection. As the Office is no doubt aware, a rejection under 35 U.S.C. §102 can only be maintained if single reference teaches each and every element of the claims. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Independent claim 1, and the claims dependent thereon, recite "at least one (meth)acrylate compound containing one or more acidic groups". This feature is neither taught nor suggested by the '391 reference. The passage cited by the Patent Office as meeting element (c) of claim 1 does not teach any acid group containing monomers.

Serial No. 10/796,681  
Art Unit: 1713

The passage states:

Additionally, numerous other mono- or multifunctional monomers which are compatible with the basic composition may be incorporated therein, in an amount of up to 30% by weight of the basic composition, insofar as they do not adversely affect the composition. Examples of such compatible monomers are vinylic compounds such as acrylamide, acrylamide derivatives, vinyl pyrrolidone and other mono- or multi-functional acrylates and/or methacrylates such as glycerol propoxy triacrylate or trimethylol propane propoxylate triacrylate. (emphasis added). Col. 12, lines 11-21.

None of the monomers mentioned in the quoted passage contain acid groups. The '391 teaches against the presence of acidic groups in its components, pointing out that such acid groups are neutralized by alkaline materials, such as amines, causing undesirable gelling, Col. 2, lines 17-36. The Patent Office must read the reference for all that it teaches. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). The '391 patent teaches that its compositions do not include use of components having acidic groups and Applicants' claim 1 requires an acidic group containing component. Accordingly, Applicants submit that the rejection of claim 1 and its dependent claims under 35 USC 102 should be withdrawn.

Regarding claim 2, Applicant submits that the viscosity of less than 300 mPas is not inherent to the '391 patent where components that are used in the '391 have much higher viscosity than Applicants', such that the '391 mixture's viscosity is outside the scope of claim 2. Specifically, Shustack '387 and '391 teach from 25 to 50 weight% of the oligomeric component (col. 4, line 49 ( 391) or col 4 l. 24 ( 387)). Taking into account that the oligomers show a higher viscosity than monomeric acrylates, Applicants submit that a composition according to Shustack will have a higher viscosity than that required in claim 2. In the '391 patent at col. 6, line 50 and at col. 8, line 43, some viscosities of used oligomeric materials are mentioned. They range from 2000 to 4200 cps (mPas) which at 25 to 50 weight% result in mixtures having a viscosity outside the range claimed in claim 2. Low viscosity is required in a process of coating metallic parts with a dry film thickness of

Serial No. 10/796,681  
Art Unit: 1713

less than 20 µm, or preferred 10 µm, which is a use for Applicants' composition. Such thin coating will provide a complete surface free of holes and pores. Such a coating would be difficult to achieve with a composition according to Shustack' 391, as mentioned on col. 11, line 19 where the particles of wax have a particle size from 5 to 20 µm, examples of used substances have a melting point above 100 C and should not melt during application and accordingly cannot provide a dense surface. Applicants submit that the '391 neither teaches nor suggests the features of claim 2 and the rejection under 35 USC 102 should be withdrawn.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack et al. (US 5,128,391). For the reasons recited above regarding the '391 patent, Applicants submit that there is no teaching or suggestion in the '391 alone that would motivate one of skill in the art to modify the reference in an attempt to achieve Applicants' claim 28.

In order to support a rejection under 35 U.S.C. §103, the Office must establish that there was some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). That is, although the Office may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski* 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA). The '391 patent teaches against using acid groups in its components. As such, one of ordinary skill in the art would not be motivated to change the '391 invention by adding at least one (meth)acrylate compound containing one or more phosphoric or carboxyl acidic functional groups. As such, the rejection of claim 28 under 35 USC 103 should be withdrawn.

**Serial No. 10/796,681**  
**Art Unit: 1713**

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack et al. (US 5,128,391) in view of Shustack et al. (US 5,128,387). Seeking to combine the two Shustack references is improper where doing so destroys the '391's teachings. The '391 specifically teaches that acidic groups are not to be used, in particular acidic adhesion promoters, see col. 2, line 36. At column 2, line 17-31 of the '391 patent, the '387 patent is distinguished stating that the '387 requires an acidic adhesion promoter. The '387 is being relied upon by the Patent Office to teach adding the very chemicals that the '391 teaches are to be avoided. As such, the combination of these references would destroy the '391 and thus cannot be used to support a rejection under 35 USC 103.

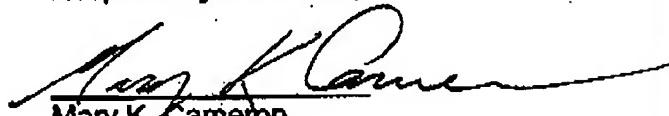
Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack et al. (US 5,128,391) in view of Razavi (US 5,629,365). Ravi '365 is directed to an aqueous latex which may contain various additives. Waterborne dispersions are different from organic based coatings and so it would not be obvious to one of ordinary skill in the art that one could simply add an additive for use in water to an organic solution and have it work. Also the intended use is different. While in Shustack the product to be coated is an aluminum cup for beverage cans the most preferred use in our invention should be the coating of metallic substrates with such permanent coating for architectural use or for metallic furniture parts. The motivation, present for products that may contaminate food such as in Ravi, to add biocide, would not motivate one of skill in the art to add biocide to a product for use on buildings or furniture. As such, the rejection of claim 28 under 35 USC 103 should be withdrawn.

Serial No. 10/796,681  
Art Unit: 1773

Conclusion

Applicants request reconsideration in view of the remarks contained herein. Applicants submit that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned

Respectfully submitted,



Mary K. Cameron  
(Reg. No. 34,789)  
Attorney for Applicants  
248-589-4672

Henkel Corporation  
Patent Law Department  
2200 Renaissance Boulevard, Suite 200  
Gulph Mills, PA 19406